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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,922	03/28/2001	Roger W. Engelbart	38190/196421	4358

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EXAMINER

BALI, VIKKRAM

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,922

Applicant(s)

ENGELBART ET AL

Examiner

Vikram Bali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,12-28 and 30-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,12-28,30-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to the amendment filed on 11/04/2004, all the amendments to the claims have been entered and the action follows:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1-8, 10, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks et al (US 5513537) in view of Beck et al (US 4415811).

With respect to claims 1-8, 10 and 14-18 the rejections are respectfully maintained and incorporated herein by reference as set forth in the previous office action, paper number 3. Furthermore, Brooks further discloses the newly added limitation of light source being positioned to illuminate the composite structure in a direction substantially perpendicular to the common direction of the composite strips, (see the figure 8 the light source is not illuminating directly perpendicular i.e. only substantially perpendicular) also, the plurality of adjacent composite strips are positioned in a common direction, (see col. 7, lines 51-56, for the composite strips being the common direction and the figure 8 for the light source as located substantially perpendicular to the common direction) as claimed in independent claims 1, 19 and 35.

4. Claims 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks et al (US 5513537) in view of Beck et al (US 4415811) as applied to claim 1 above, and further in view of Weyenberg (US 5359525).

With respect to claim 9 the rejections are respectfully maintained and incorporated herein by reference as set forth in the previous office action, paper number 3.

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5. Claims 12-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks et al (US 5513537) in view of Beck et al (US 4415811) as applied to claim 1 above, and further in view of Bjork (US 6295129).

With respect to claims 12-13 the rejections are respectfully maintained and incorporated herein by reference as set forth in the previous office action, paper number 3.

Claims 19-28, 30-33 are rejected as the reasons set forth in the rejections for claims 1-10, 12-18, because claims 19-28, 30-33 are claiming subject matter as claimed in claims 1-10, 12-18.

Claim 35 is rejected for the reasons as set forth in the rejection of claim 1+10+17+19, because claim 35 is claiming limitations as set forth and rejected in the claim 1+10+17+19. Furthermore, having a moving camera and the light source is a design choice, because one ordinary skilled in the art at the time of invention can simply consider either moving the camera and light source or the strip in order to inspect the entire strip of the sample. Therefore, it would have been obvious to one ordinary skilled in the art at the time of invention to have moving camera and the light source to inspect the entire strip of composite structure, as it depends on the field view of the camera.

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Claims 36-41 are rejected as the reasons set forth in the rejections for claims 2-10 and 12-15, because claims 34-41 are claiming subject matter as claimed in claims 2-10 and 12-15.

Response to Arguments

6. Applicant's arguments filed 11/04/2005 have been fully considered but they are not persuasive. Applicant argues that the combination fail to disclose identifying defects based upon the **differential reflection of the light** as recited by the claimed invention, (see page 10 paragraph 1) of remarks. The limitation is not claimed in the independent claimed invention.

Applicant argues that the reference fail to teach the method that relies upon the reflection of the light to detect the defects, as claimed. Examiner respectfully disagrees and would point out the col. 11 and 12 description of figure 8 staring line 45 to col. 12 line 15 describes the inspection system that uses the reflected light in order to detect the defects, as claimed.

Applicant argues that the reference fail to disclose the angle is about 45 degrees see page 12 paragraph 2 of the remarks. Examiner disagrees with the applicant and would like to point out the reference `537, see col. 11, last two lines, states that the angle of the light source is adjusted in order to get the best illumination, therefore one ordinary skilled in the art can very well make the angle best suited for the inspection, thereby

choosing any angle for the light source, one can use any angle as best suited for the inspection, that might very well be about 45 degrees, as claimed.

With respect to the hindsight argument, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vikkram Bali whose telephone number is 571.272.7415. The examiner can normally be reached on 7:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 571.272.7414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vikkram Bali
Primary Examiner
Art Unit 2623

vb
May 25, 2005